

Atty. Dkt. No. 035451-0119 (3597.Palm.SG)

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

In Section 2 of the Office Action, the Examiner rejected claims 1-39 under 35 U.S.C. 103(a) as being unpatentable over Hachiman et al. in view of Haitani et al. The Examiner stated:

Hachiman et al. teach a docking station for a handheld computer, Figs. 1-17, comprising: a data connection configured to communicate data from the docking station 1 to the handheld computer 2 and from the docking station 2 to a personal computer 300 (inherently comprising as it is well known in the art a communication bus, and coupled to said communication bus a storage device, a memory, and a processor); and an expansion card 600 connector 57, Fig. 11, coupled to the docking station and configured to communicate data between an expansion card 600 and the docking station 1. Hachiman et al. teach furthermore said docking station having a wireless data link 64, Fig. 11, or a modem data link 500, Fig. 8, to communicate data to a communication network. Hachiman et al. does not teach said docking station being a synchronization docking station. Haitani et al. teach a docking station – a synchronization cradle 320, Fig. 5 for a handheld computer 330 comprising: a data connection configured to communicate data from the docking station 320 to the handheld computer 330 and from the docking station to a personal computer 310, wherein said docking station comprising a start synchronization button 325. It would have been obvious to one skilled in the art at the time invention was made to employ a synchronization docking station as it is shown by Hawkins et al. in the device by Haitani et al. in order to avoid including in the system a separate synchronization device.

Regarding to the claims 7, 14-15, 21-30 and 35: The functional recitations that the claimed hardware includes computer programs configured to perform certain tasks has been given patentable weight because it is narrative in form. In order to be given patentable weight a functional recitation must be expressed as a "means" for performing the special

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function, as set forth in 35 U.S.C. § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In re Fuller, 1929 C.D. 172; 388 O.G. 279. In view of the above examiner directs applicant's attention to the fact the neither the disclosure nor the drains of the instant application comprise any description or block diagrams or codes of any computer programs. Also it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding to the claims 11, 12, 17-19, 33, 34: Hachiman et al. and Haitani et al. disclose the claimed invention except for: a secure digital card (SD), or a multimedia card (MMC), or a battery, or a cellular phone transceiver, or a camera, or a MP3 player being inserted into a card slot of the docking station (by Hachiman et al. card 600 is a memory card without specifying its kind). It would have been an obvious matter of design choice to use said card slot to insert a secure digital card (SD), or a multimedia card (MMC), or a battery, or a cellular phone transceiver, or a camera, or a MP3 player, since applicant has not disclosed that a type of the inserted device solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any kind of available electronic device having appropriate size and electrical connection. Regarding to the claims 35-39: The method steps are obviously necessitated by the device structure as Hachiman et al. and Haitani et al. describe it.

With regard to independent claims 1, 13, 21, and 35, the claims are directed to a combination of elements which includes the use of a docking station or cradle that includes an expansion card connector, and from which data on an expansion card coupled to the expansion card connector is read by a personal computer communicating with the docking station or cradle. Neither Hachiman et al. nor Haitani et al. disclose, teach, or suggest, alone, or in any proper combination, the use of a docking station or cradle that communicates with a personal computer where the personal computer has running thereon a program that is able to communicate with the docking station or cradle and can read data files from the expansion card or can read the contents stored on the expansion

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card. Further, in claim 21, the personal computer is configured to display to a user a listing of the contents of the expansion card. Hachiman et al. and Haitani et al. do not contemplate the use of the docking station or cradle for convenient exchange of data from data cards or other expansion cards to a personal computer. Hachiman et al. appears to provide an expansion card slot, albeit not clear as to the use, the expansion card slot is assumed to be used for providing data to the handheld computer because the docking station is simply a portable docking station. Applicants contemplated the ease of using a docking station with an expansion card connector or slot for reading files from the expansion card connected to the connector into a personal computer as well as into the handheld computer. Accordingly, Applicants respectfully submit that independent claims 1, 13, 21, and 35 are not rendered obvious by the combination of Hachiman et al. and Haitani et al. Beyond the fact that neither Hachiman et al. nor Haitani et al. provides all of the elements of the independent claims as amended, Hachiman et al. and Haitani et al. do not provide any motivation to combine the references to provide for a docking station for a handheld computer that doubles as an expansion card reader for a personal computer. Accordingly, independent claims 1, 13, 21, and 35 and their respective dependent claims are allowable.

With respect to the Examiner's comments regarding claims 7, 14-15, 21-30 and 35, to which there is no rejection under any additional statutory section beyond § 103, Applicant's respectfully disagree with the Examiner's comments. First, the Examiner states that "in order to be given patentable weight, a functional recitation must be expressed as a 'means' for performing the special function, as set forth in 35 U.S.C. § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language." Applicants respectfully submit that the claims are not in 'means' form under 35 U.S.C. § 112, 6th paragraph, and Applicants do not believe that they are required to place the claims in such form. "There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not in and of itself render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)." MPEP § 2173.05(g). "A functional limitation must

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be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient, or step. Whether or not the functional limitation complies with 35 U.S.C. § 112, 2nd paragraph, is a different issue from whether the limitation is properly supported under 35 U.S.C. § 112, 1st paragraph, or is distinguished over the prior art." Id.

Applicants respectfully submit that one of ordinary skill in the art would appreciate how a computer could be programmed to read an expansion card from an expansion card connector that is built into a docking station or cradle. Further, Applicants provide support for and description of the function referred to. Applicants direct the Examiner's attention to paragraph 22 in particular, as well as FIG. 2 which shows an exemplary screen display of a expansion card reader program running on the personal computer as well as an exemplary block diagram, in FIG. 4, showing the cradle coupled to a personal computer 410. Further still, Applicants submit that the claims themselves also serve as part of the disclosure. Thus, the Examiner's assertion that there is no disclosure in any of the drawings, description, or block diagrams of any computer programs is erroneous. Accordingly, Applicants believe that independent claims 1, 13, 21, and 35, and their respective dependent claims, are allowable.

After amending the claims as set forth above, claims 1-4, 6, 8-13, and 15-39 are now pending in this application. Claims 5, 7, and 14 have been cancelled without prejudice.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

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The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date May 05, 2003

FOLEY & LARDNER
Suite 3800
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-5306
Telephone: (414) 297-5730
Facsimile: (414) 297-4900

By Alistair K. Chan

Alistair K. Chan
Attorney for Applicant
Registration No. 44,603

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MAY 05 2003

TECHNOLOGY CENTER 2800